

## **REMARKS**

The Examiner is thanked for the examination of the application. In view of the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

Claims 2-5, 8-11, and 14-17 are cancelled. New Claims 20-33 are presented for consideration. Thus, Claims 1, 6, 7, 12, 13, and 18-33 are pending.

### **Information Disclosure Statement (IDS)**

An IDS is submitted with filing for consideration by the Examiner.

### **Rejections Under 35 U.S.C. § 102(b)**

Claims 1, 2, 5-8, 11-14 and 17-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Teraura (U.S. Patent No. 6,827,279). Initially, Applicants respectfully point out that it appears this rejection was intended to be made under 35 U.S.C. § 102(e), based on the filing date of the cited reference. As noted above, Claims 2, 5, 8, 11, 14 and 17 are cancelled, rendering the rejection of these claims moot.

Regarding Claims 1, 7, and 13, the Office Action notes that Teraura shows all of the elements of the claims, including a transporting unit, a judging unit (at A2), a reading unit, and a printing unit. The Office Action further states that Teraura discloses the judging unit to judge whether a document is electronically tagged printed matter, wherein image data is printed on an electronically tagged document paper equipped with an electronic tag that stores image data.

Claims 1, 7, and 13, as amended, recite the additional features of a printing paper judgment unit for judging whether there is an instruction for printing image data on an electronically tagged printing paper, and that the reading unit reads image data from the electronic tag when the printing paper judgment unit judges that there is an instruction for printing on an electronically tagged printing paper. Additionally, these claims now recite that the printing unit issues a blank paper as output when a documents is judged not as an electronically tagged matter by the document judgment unit while the printing paper judgment unit judges that there is an instruction for printing on a printing paper equipped with an electronic tag. The issuance of the blank paper corresponds to step S145 in Fig. 9. However, the present invention is not limited to the disclosed embodiments.

Applicant respectfully submits that Teraura does not disclose the printing paper judgment unit as claimed. In Teraura, an operator presses a start key on the device to feed a sheet of paper 61 to a document paper feeding path 4 to read an image including characters or figures on the sheet with a scanner 6 (step B1). Here, a control circuit judges whether the sheet has an RFID tag. If no RFID tag is detected, then the control circuits selects usual printing paper to be printed on (column 8, lines 11-21). If an RFID tag is detected, the control circuit controls a first reader-writer 15 to read the data in the RFID tag 14 (column 8, lines 22-27). The control circuit then checks the RFID tag for permission data. If none is found, it indicates the person making the copy is not restricted. The control circuit then selects printing paper containing RFID tags for printing thereon (column 8, lines 28-37). Thus, the device does not judge whether there is an instruction for printing an image on an electronically tagged printing paper, but rather, determines based solely

on the existence of an RFID tag in the document to be copied, which type of paper will be used.

As described in the instant specification, once a tagged document is detected, a user is presented with a prompt 420 for instructions on whether to print to IC-tagged paper. Once this instruction is received, the printing judgment unit will direct the printing unit to proceed accordingly. Thus, a user inputs instruction to determine whether the printing paper will be IC-tagged or usual printing paper. However, the present invention is not limited to the disclosed embodiments.

Further, Teraura does not disclose that a printing unit issues a blank paper as output when the a document is judged not as an electronically tagged matter, while the printing paper judgment unit judges that there is an instruction for printing on a printing paper equipped with an electronic tag. In Teraura, there is no discussion of outputting a blank sheet of paper. Rather, the output is determined only on the basis of there being an RFID tag on the paper being copied, and permission data stored thereon.

As described in the instant specification, once an IC tag is detected in a document set at 102, the user will be prompted with a display 420 (at S113) asking whether to print on IC tagged paper. If the user selects 'Yes', then the printing paper judgment unit judges that there is an instruction to print on IC-tagged paper. The user is then prompted on what type of output they would like for non IC tagged documents that may exist in the document set. Among these options is to output blank paper (S117). Once selected, documents within the document set which do not include an IC tag are detected by reader 143B, and the output will be a blank sheet of paper. The IC-tagged documents will be copied to IC-tagged paper based

on the imaged stored on the IC tag. However, the present invention is not limited to the disclosed embodiments.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 3, 9, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Teraura in view of Hopper (U.S. Patent No. 7,099,029). The Office Action correctly notes that Teraura does not disclose a blank page to be output by the device. The Office Action relies on the teachings of Hopper to cure this deficiency. Applicant respectfully traverses this rejection. It is noted that while Claims 3, 9 and 15 are canceled by this Amendment, the subject matter has been incorporated into independent Claims 1, 7, and 13.

Hopper teaches an intelligent print controller that prints a special encoded mark on a paper, and at a subsequent printing device, watches for the encoded marks, and prints a blank sheet of paper (column 4, lines 46-57). The mark appears to be used only for identification purposes, and is not any sort of electronic tag. No information is printed that is obtained from the mark, nor is there any determination of the type of paper to print on (tagged or usual). This teaching, when combined with Teraura, still does not result in the claimed subject matter. When combined with Teraura, the teachings of Hopper suggest including an encoded identification mark on the paper in Teraura. In Hopper, there is no discussion of a document judgment unit judging whether a document is an electronically tagged printed matter, thus the output of a blank sheet of paper is not based on the judgment of a document judging unit. Neither Hopper, nor Teraura disclose a blank paper being issued as output when a document is judged not as electronically tagged matter by the document

judgment step, while the printing paper judgment step judges that there is an instruction for printing on a printing paper with an electronic tag.

Claims 4, 10 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Teraura in view of Cherry et al. ("Cherry", U.S. Patent Application Publication No. 2003/0151762). The Office Action correctly notes that Teraura does not disclose a printing unit that when a document is judged as non electronically tagged matter prints no output. However, the Office Action relies on the teachings of Cherry to cure this deficiency. Although originally filed Claims 4, 10, and 16 are canceled by this Amendment, the subject is incorporated into new Claims 20, 24, and 28.

Cherry teaches a system for authorizing printing services where if an incorrect authorization code is provided, the print job is denied, and nothing is printed (paragraph [0005]). The combination of Teraura and Cherry would result in a printing system that requires an authorization code in order to operate. The combination of Teraura and Cherry does not disclose the printing unit to issue no output when a document is judged not as an electronically tagged matter by a document judgment unit while a printing paper judgment unit judges that there is an instruction for printing on a printing paper equipped with an electronic tag. Applicant respectfully submits that this rejection be withdrawn.

New Claims 21, 25, and 29 are submitted with this Amendment for consideration. These claims each recite, in combination with the other claimed features, a first judgment unit for judging whether a series of documents on a document tray contains at least one electronically tagged printed matter, a transporting unit for transporting documents, and a second judgment unit for

individually judging whether each of the transported documents is an electronically tagged printed matter. These features are not disclosed by Teraura or any of the other cited prior art in the most recent Office Action. In Teraura, only individual sheets are judged for the presence of an RFID tag. Accordingly, Applicant submits that Claims 23, 27, and 31 overcome the cited prior art and are in condition for allowance.

Dependent Claims 6, 12, 18, 19, 22, 23, 26, 27, and 30-33 ultimately depend from the independent claims addressed above. For at least this reason, it is submitted that these claims are also allowable.

For at least the reasons cited above, it is respectfully submitted that is application is now in condition for allowance. In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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